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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,985	01/19/2001	Michael A. Sharp	65-1	1204
<div>7590 MICHAEL SHARP P O BOX 101 PORTER, TX 77365</div>				
<div>08/02/2007</div>				
<div>EXAMINER MYHRE, JAMES W</div>				
<div>ART UNIT 3622</div>				
<div>PAPER NUMBER</div>				
<div>MAIL DATE 08/02/2007</div>				
<div>DELIVERY MODE PAPER</div>				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/765,985	<b>Applicant(s)</b> SHARP, MICHAEL A.	
	<b>Examiner</b> James W. Myhre	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

1. This Office Action is in response to the initial filing on January 19, 2001. Claims 1–10 are currently pending and have been considered below.

### ***Information Disclosure Statement***

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Objections***

3. Claim 8 is objected to because of the following informalities: in line 6, the word "endusers" needs to be split into two words "end users". Appropriate correction is required

### ***Specification***

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract

Art Unit: 3622

on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The Abstract contains 262 words. Additionally, the Abstract contains a typographical error in line 11 where the phrase "are combined" is repeated in sequence.

Appropriate corrections are required.

5. The disclosure is objected to because of the following informalities: on page 3, there is a line of extraneous material across the top of the page.

Appropriate correction is required.

### ***Drawings***

6. The drawings and description are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the reference signs for each of the features mentioned in the description. The lack of reference signs renders it difficult to ascertain with any degree of certainty which part of the drawings correlate to the discussed features in the disclosure. A substitute specification and corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should

include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-4 are directed to a data file comprising a first segment (ad) and a second segment (music) in various formats (wav, MP3, or compressed). However, since no functionality is being performed by the data file, it is considered to be non-functional data per se, which places the claims under non-statutory subject matter. Additionally, even if one were to argue that the data file was a program (although the Examiner has never seen a program in MP3 format) the claims would still be non-statutory in that a computer program needs to be stored on a computer readable medium and the claim be directed towards the computer readable medium (i.e. a product claim) in order to be statutory.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 5, 8, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Wolfe et al(5,931,901).

Claim 1: Wolfe discloses a data file comprising an advertising message and a musical composition (column 2, lines 18-41 and column 4, lines 7-25).

Claim 5: Wolfe discloses a method for distributing advertising, comprising combining an advertising message data file with a musical composition data file (column 2, line 60 – column 3, line 3 and column 6, line 21 – column 7, line 5).

Claim 8: Wolfe discloses a method for distributing music, comprising:

- a. purchasing rights to multimedia files thereby obtaining licensing data (column 4, lines 18-25 and column 5, lines 26-44);
- b. combining a multimedia file with an advertising data file and licensing data (column 2, line 60 – column 3, line 3 and column 6, line 21 – column 7, line 5);

Art Unit: 3622

- c. sending the combined file to end users (column 2, line 60 – column 3, line 3; column 6, line 21 – column 7, line 5; and column 7, lines 39-64); and
- d. charging fees to the advertiser providing the advertising file (column 4, lines 18-25 and column 5, lines 26-44).

Claim 9: Wolfe discloses a method as in Claim 8 above and further discloses the multimedia file comprises a musical composition (column 2, lines 18-30 and column 4, lines 18-25).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe et al (5,931,901).

Claims 6 and 7: Wolfe discloses a method as in Claim 5 above that combines the advertising data file with the music data file, but does not explicitly disclose the type of editor doing the combining. As discussed by the Applicant, both sound editors and hexadecimal editors (e.g. HEX editor A.X.E.) were known at the time the invention was made (page 6). Therefore, it would have been obvious to one having ordinary skill in

Art Unit: 3622

the art at the time the invention was made to use known editors, such as sound or Hexadecimal editors, to combine the data files in Wolfe. One would have been motivated to use either of these known editors in order to efficiently combine the files without having to develop your own editor.

13. Claims 2-4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe et al (5,931,901) in view of Weisberg et al (6,351,736).

Claims 2-4 and 10: Wolfe discloses a data file and method as in Claims 1 and 8 above, but does not explicitly disclose that the data file (multimedia file) is in a wav, MP3, or compressed format. However, Weisberg discloses a similar data file and method for distributing advertising and multimedia files that further discloses using files in wav, MP3, or compressed formats (column 1, lines 24-27 and column 5, lines 37-41).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to format the data file in Wolfe using any of the standard formats known at the time to include wav, MP3, or other compression formats. One would have been motivated to use such compression formats in order to reduce the amount of bandwidth needed to transmit these large audio files such as discussed by Weisberg.



***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Neel et al (5,838,314) discloses a method for combining an advertising file with a multimedia file.

b. Chatani et al (7,047,302) discloses a method for combining an advertising file with primary content files, to include audio and video files.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 3622

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August 1, 2007



James W. Myhre  
Primary Patent Examiner